

### **THE AMENDMENT**

Claims 69-122 are in the case. Claims 70, 79, 87-89, 92, 100, 103-104, 106, 115 and 120 have been amended. Claims 121-122 are new.

The amendments to claims 87, 92, 103 and 120 are to clarify the claim by addressing grammatical inconsistencies and providing wording consistent with method claim format. The amendments to claims 70, 79 (step D), 87 (step B), 88, 89 (relation to claim 79), 92 (steps C and D), 100 (relation to claim 92), 104 and 106 (relation to claim 113) are to address grammatical errors that are apparent from their context and to provide appropriate antecedent basis.

Support for the amendment to claims 69, 79, 92, 106 and 115 regarding “without altering or producing the game outcome” can be found at ¶ [21] (page 6) and at ¶ [27]-[28] (page 7) of the original Specification.

The amendments to claim 79 and 92 regarding “... moving ... during game play ...” is based on wording found in previously presented claims 75, 87, 103, 111, 115 and 117. The amendments to claims 79, 89, 92 and 100 regarding “... locating ... in a first position (after a game outcome) ...” is based on wording found in previously presented claim 120.

New claim 121 is based on incorporating claim 89 into claim 79; new claim 122 is based on incorporating claim 100 into claim 92 -- see discussion below (**Section 4**) regarding **Allowable Subject Matter**.

Applicants respectfully submit that the Amendment does not introduce new matter and request that the Amendment be entered.

## **REMARKS**

### **1. A Brief Review of One Embodiment of Applicants' Invention**

In one embodiment of Applicants' invention, a gaming device has a moveable game element that is located in a display area and is moveable in at least a first and second manner. A controller is located in the housing and is in communication with the moveable game element. The controller determines a game outcome, which may be a winning or losing outcome. The controller preferably moves the moveable game element in a first manner during game play and in a second manner after the controller determines a threshold number of consecutive outcomes of the same type. For example, after a number of losing outcomes, the controller can move one or more of the reels in a direction opposite to the normal direction of rotation.

Another embodiment of Applicants' invention comprises a method of playing a game. The method includes placing a wager and displaying a game on a gaming device. The game display preferably includes a plurality of moveable objects. The moveable objects are preferably moved in a first manner during the game. For instance, the moveable objects may be moved such that they all move in the same direction. The game also includes determining a game outcome, which may be a winning or losing outcome. The method also preferably includes determining the number of consecutive losing events. The moveable objects are moved in a second manner if the number of consecutive outcomes of the same type is at least a threshold number. For example, the second manner of movement may include moving the moveable objects such that they move in different directions.

In another embodiment of Applicants' invention, a gaming device has a player input device and a moveable game element. A controller is located in the housing and is in communication with the moveable game element. The controller determines a game outcome,

which may be a winning or losing outcome. The controller moves the moveable game element in a first manner during game play and allows the player to use the player input device to cause the moveable game element to move in a second manner during non-game play. This feature provides a game player with the illusion that they are influencing the outcome of the game.

**2. Rejection of claims 89, 100 and 120 as being indefinite under 35 U.S.C. §112, second paragraph.**

Claims 89 and 100 stand rejected as being unpatentable under 35 U.S.C. §112 as being indefinite. Applicants respectfully traverse this rejection.

Applicants submit that currently amended claims 89 and 100 now provide proper antecedent basis regarding the position of the elements in relation to their corresponding parent claims. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112.

Claim 120 stands rejected as being unpatentable under 35 U.S.C. §112 as being indefinite. Applicants respectfully traverse this rejection.

Applicants submit that currently amended claim 120 no longer refers to the order of the steps and that it would be apparent to one of ordinary skill in the art that “returning the objects to the first position (step D)” corresponds to the position of the objects referred to in step B. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112.

**3. Rejection of claims 69-88, 90-99 and 101-119 as being obvious over Parker et al. (GB 2062922) in view of Stupak (U.S. Patent No. 6024642).**

Claims 69-88, 90-99 and 101-119 stand rejected as being unpatentable over Parker et al. in view Stupak under 35 U.S.C. §103(a). Applicants respectfully traverse this rejection.

Stupak appears to disclose a slot or video gaming machine modified to include a successive loss counter/indicator, and to pay a jackpot amount if the results of a predetermined number of successive games played on the machine are losing results.

Parker et al. appears to disclose a gaming machine having a nudge feature whereby a player may manipulate the outcome of a game by influencing the alignment of symbols to provide a winning combination.

Neither Stupak nor Parker et al. teach or suggest Applicants' claimed invention as provided in newly amended independent claims 69, 79, 92, 106 and 115 (and corresponding dependent claims), in particular, the requirement that the second manner of object movement occurs without altering or producing the game outcome.

The Office contends that it would have been obvious to combine the feature of Stupak (including determining a predetermined number of successive losses) into the game of Parker et al., and presumably arrive at Applicants' claimed invention. However, Parker teaches away from Applicant's claimed invention (by using the nudge feature to affect the outcome of the current game), and there would be no incentive to one of ordinary skill in the art to combine the features of Stupak into a game that is incompatible with the requirements of Applicants' claimed invention. Even if one were to combine the teachings of Stupak with the teachings of Parker et al., the resulting combination would operate in direct contrast to Applicants' claimed invention.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established since "... all the claim limitations must be taught or suggested by the prior

art ...” (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

#### **4. Allowable Subject Matter**

The Office has indicated that claims 89 and 100 would be allowable if rewritten to overcome the outstanding rejection under 35 USC §112 and include any limitations of the corresponding base claims. Applicants respectively submit that new claims 121 (based on incorporating claim 89 into base claim 79) and 122 (based on incorporating claim 100 into base claim 92) have addressed the outstanding rejection under 35 USC §112 and incorporated all the limitations of the base claims, as suggested by the Office. Accordingly, Applicants respectfully request the allowance of new claims 121-122.

The Office has indicated that claim 120 would be allowable if rewritten to overcome the outstanding rejection under 35 USC §112. Applicants respectively submit that the amendment to claim 120 has addressed the outstanding rejection under 35 USC §112. Accordingly, Applicants respectfully request the allowance of currently amended claim 120.

#### **Conclusion**

Based on the arguments presented above, Applicants respectfully submit that the rejections have been overcome and request allowance of the claims. If the Office has any questions regarding the application or this response, the Office is encouraged to call Applicants’ attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,

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